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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,716	10/06/2006	Juan Manuel Pedraza Sanz	130260.00201	3258
21269	7590	10/03/2008	EXAMINER	
PEPPER HAMILTON LLP ONE MELLON CENTER, 50TH FLOOR 500 GRANT STREET PITTSBURGH, PA 15219				ANGWIN, DAVID PATRICK
ART UNIT		PAPER NUMBER		
3729				
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		10/03/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/599,716	PEDRAZA SANZ, JUAN MANUEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID P. ANGWIN	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 September 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-6** are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically:

- a. **Claim 1** recites the following limitations that are vague, indefinite, and confusing:
  - "so that turns are perfectly formed without the need to involve manual work thereon" (claim 1, lines 5-6) – It is unclear as to what a "perfectly formed" turn is when worked on by wheels "mounted on a pressure head." Please be more precise with the claim language.

### Claim Rejections - 35 USC § 102

The following is a set of quotations of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6**, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by *Hartwig* (DE 2530312).

- a. *Hartwig* discloses the following:

- i. a pressure head (Figs. 1-2, item 1) mounted on a support (Figs. 1-2, item 13);
- ii. a set of vertical wheels and a horizontal wheel mounted on the pressure head which work on the conductor (Figs. 1-2);
- iii. a feeder (Figs. 1-2); and
- iv. a control unit (Figs. 1-2; 2:31-48).

In the alternative, **claims 1-2**, as best understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by *Okuda et al* (JP Patent 11-345732).

- a. *Okuda et al* discloses the following:
  - i. a pressure head (Figs. 3-4, item 121) mounted on a support (Figs. 1 and 3-4, item 122);
  - ii. a set of vertical wheels (Figs. 3-4, items 105 and 127) and a horizontal wheel (Figs. 3-4, items 123 and 126) mounted on the pressure head which work on the conductor;
  - iii. a feeder (Fig. 1, item 20); and
  - iv. a control unit (Figs. 1 and 3-4, items 61 and 65-67; in the alternative, Figs. 1 and 3-4, item 124).

#### **Claim Rejections – 35 USC § 103**

The following is a quotation of 35 U.S.C. § 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically taught or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

In the alternative, **claims 3-6**, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Okuda et al* (JP 11-345732) in view of *Hartwig* (DE 2530312).

- a. In addition to the above limitations, *Okuda et al* does not expressly disclose a control unit transmitting commands to hydraulic parts associated with vertical and horizontal wheels.
  - i. However, *Hartwig* teaches a control unit (2:33-34; Figs. 1-2) that transmits commands to hydraulic parts associated with vertical and horizontal wheels (2:31-48; Figs. 1-2). The advantage of a control unit that transmits commands to hydraulic parts associated with vertical and horizontal wheels is to more effectively control a conductor in tension. Thus, it would have been obvious to utilize a control unit to transmit commands to hydraulic parts associated with vertical and horizontal wheels to more effectively control a conductor in tension.

In the alternative, **claims 3-6**, as best understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Okuda et al* (JP 11-345732) in view of *Hartwig* (DE 2530312) and *Chang et al* (US Patent 5,644,486).

- a. In addition to the above limitations, *Okuda et al* does not expressly disclose hydraulic parts associated with vertical and horizontal wheels.
  - i. However, *Hartwig* teaches hydraulic parts associated with moving mechanical devices (2:31-48; Figs. 1-2). The advantage of using hydraulic parts associated with moving mechanical devices is to provide additional force required to effectively and safely move the mechanical devices. Therefore, it would have been obvious to use hydraulic parts associated with moving mechanical devices to provide additional force required to effectively and safely move the mechanical devices.
- b. In addition to the above limitations, *Okuda et al* as modified does not expressly disclose a control unit transmitting commands to hydraulic parts associated with vertical and horizontal wheels.
  - i. However, *Chang et al* teaches a control unit (1:10-23; Fig. 1) that transmits commands to mechanical devices. The advantage of using a control unit to transmit commands to mechanical devices is to precisely control the movement of the mechanical devices. Thus, it would have been obvious to use a control unit to transmit commands to hydraulic parts associated with vertical and horizontal wheels to precisely control the movement of the mechanical devices.

### **Response to Arguments**

In the applicant's responses dated 7/10/08 and 9/19/08, the applicant argues that the reply period should be reset because the Office did not provide him with translations of the cited references. However, machine translations of these documents are readily available online. Therefore, the examiner has not been persuaded to reset the reply period. For the applicant's convenience, the examiner hereby provides the applicant with a copy of the foreign and translated versions of the foreign cited prior art.

In addition, in the applicant's 9/19/08 response, the applicant amended his claims based upon the examiner's First Action on the Merits. Therefore, as a result of both responses by the applicant, the examiner properly makes this action Final.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Angwin whose telephone number is 571-270-3735. The examiner can normally be reached on 7:30 AM - 5 PM (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo, can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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